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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,551	05/10/2006	Hans Petersen	05432/1200028-US1	9953
7278	7590	05/21/2007		
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257				
			EXAMINER RAHMANI, NILOOFAR	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 05/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/570,551	Applicant(s) PETERSEN ET AL.	
	Examiner Niloofer Rahmani	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 37 is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-37 are pending in the instant application.

2. ***Priority***

This application is filed on 05/10/2006, which is a 371 of PCT/DK04/00579, filed on 09/01/2004, which claims benefit of 60/500,422, filed on 09/05/2003, which claims the priority DENMARK PA200301277, filed on 09/05/2003.

3. ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15, 18, and 20-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-15, 18, and 20-36 are rejected because the term "THIP" is confusing. What is the formula of "THIP"? Correction is required.

4. Claims 1-15 are rejected because the term "mild" is confusing. How mild is reducing agent can be? Is it temperature mild or is it mild reacting? Correction is required.

5. Claims 11 and 31 are rejected because the term "**S**" is confusing.

What is **S** means? It appears to be .could you do it clearly?

Correction is required.

6. Claims 14 and 34 are rejected because the term "high purity" is confusing. How pure is how purity? Correction is required.

7. Claims 14 and 34 are rejected because the term "according to HPLC" is confusing. What is the difference between the test results for HPLC or GC or etc.? Correction is required.

8. ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15, 20-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification lacks enablement of the term "leaving group", which are claimed in the compound claims. While enabling for some leaving group for example Br of the instant specification, it is not seen where this is enables other types of leaving group. Therefore, the specification lacks

enablement for the term "leaving group" beyond the leaving group disclosed in the instant specification.

9. Claims 1-15, 20-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification lacks enablement of the term "mild reducing agent", which are claimed in the compound claims. While enabling for some mild reducing agent for example LiBH_4 of the instant specification, it is not seen where this enables other types of mild reducing agent. Therefore, the specification lacks enablement for the term "mild reducing agent" beyond the mild reducing agent disclosed in the instant specification.

10. Claims 1-15, 20-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification lacks enablement of the term "nucleophile", which are claimed in the compound claims. While enabling for some nucleophile for example Br^- of the instant specification, it is not seen where this enables other types of nucleophile. Therefore, the specification lacks enablement

for the term "nucleophile" beyond the nucleophile disclosed in the instant specification.

11. Claims 1-15, 20-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification lacks enablement of the term "alkylating agent", which are claimed in the compound claims. While enabling for some alkylating agent for example Mel of the instant specification, it is not seen where this is enables other types of alkylating agent. Therefore, the specification lacks enablement for the term "alkylating agent" beyond the alkylating agent disclosed in the instant specification.

12. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification lacks enablement of the term "dehydrating agent", which are claimed in the compound claims. While enabling for some dehydrating agent for example thionylchloride of the instant specification, it is not seen where this is enables other types of dehydrating agent. Therefore, the

specification lacks enablement for the term "dehydrating agent" beyond the dehydrating agent disclosed in the instant specification.

13. Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

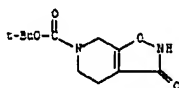
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Krogsgaard-Larsen et al., Acta Chemica Scandinavica B, 1977, Vol.31., pages 584-588. Krogsgaard-Larsen et al. disclosed the instant claimed compounds on claim 19 and method of preparing THIP using the compounds on the claim 19 on page 585, scheme 2. Therefore, the instant claim is anticipated by Krogsgaard-Larsen et al.

14. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Perregaard et al., US 4,353,910. Perregaard et al. disclosed the instant claimed compound, which is from the STN search is

RN 83491-28-5

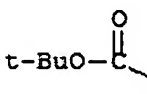
CN Isoxazolo[5,4-c]pyridine-6(2H)-carboxylic acid, 3,4,5,7-tetrahydro-3-oxo-, 1,1-dimethylethyl ester



Therefore, the instant claim is anticipated by Perregaard et al.

15. Allowable Subject Matter

Claims 17 and 37 are patentable over Perregaard et al., US

4,353,910. The reference teaches  as substituents of pyridine ring instead of the H in claim 1 and different substituted as claim 37 of the instant application. Therefore, the claims are free of prior art.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

05/10/2007

NK


MARGARET SEAMAN

PRIMARY EXAMINER

GROUP 1625